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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,307	12/12/2003	Anthony J. Baerlocher	112300-1846	1678
29159	7590	11/15/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			RADA, ALEX P	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/734,307

Applicant(s)

BAERLOCHER ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/22/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.

A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,676,516. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-33 of U.S. Patent No. 6,676,516 "anticipates" application serial number 10/734,307 of claims 1-18. Accordingly, the application of claims 1-18 are/is not patentably distinct from U.S. Patent No. 6,676,516 of claims 1-33. Here, U.S. Patent No. 6,676,516 of claims 1-33 requires elements a primary game including a plurality of player selectable indicators, each the selectable indicator being a success indicator or a failure indicator, and an independent probability of success associated with each of the selectable indicators, a display device for displaying the selectable indicators, a selector for enabling a player to select the selectable indicators, and a processor for communicating with the display device and the selector, independently determining if each selectable indicator is a success

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indicator or a failure indicator before a player selects the selectable indicators and based on the independent probabilities of success associated with the selectable indicators and providing an the award, if any, to the player based on the number of selected indicators which are selected by the player and are success indicators while the application serial number 10/734,307 of claims 1-18 only requires elements of a plurality of player selectable indicators, an independent probability of success associated with each player selectable indicator, a display device, and a processor operable with the display device to: (a) display the plurality of selectable indicators, (b) enable a player to select one of the selectable indicators, (c) independently determine whether the selected indicator is a success indicator or a failure indicator, wherein the determination is based on the independent probability of success associated with the selected indicator, (d) provide the player an award if the determination is that the selected indicator is a success indicator, wherein the provided award for the selected success indicator is greater than at least one award, if any, previously provided to the player for selecting a success indicator, and (e) repeat steps (b) to (d) until the determination is that the selected indicator is a failure indicator or the player selects all of the selectable indicators. Thus it is apparent that the more specific U.S. Patent No. 6,676,516 of claims 1-33 encompasses the application of claim 1-18. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

3. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,315,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-41 of U.S. Patent No. 6,315,664 "anticipates" application serial number 10/734,307 of claims 1-18.

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Accordingly, the application of claims 1-18 are/is not patentably distinct from U.S. Patent No. 6,315,664 of claims 1-41. Here, U.S. Patent No. 6,315,664 of claims 1-41 requires elements a plurality of player selectable indicators, each of the selectable indicators being a success indicator or a failure indicator, an independent probability of success associated with each of the selectable indicators, a display device for displaying the selectable indicators, a selector for enabling a player to select the selectable indicators, a plurality of awards, and a processor for communicating with the display device and the selector, independently determining if each selected indicator is a success indicator or a failure indicator after a player selects the selected indicator and based on the independent probability of success associated with the selected indicator, and providing one of the awards to the player for each selected indicator which is a success indicator while the application serial number 10/734,307 of claims 1-18 only requires elements of a plurality of player selectable indicators, an independent probability of success associated with each player selectable indicator, a display device, and a processor operable with the display device to: (a) display the plurality of selectable indicators, (b) enable a player to select one of the selectable indicators, (c) independently determine whether the selected indicator is a success indicator or a failure indicator, wherein the determination is based on the independent probability of success associated with the selected indicator, (d) provide the player an award if the determination is that the selected indicator is a success indicator, wherein the provided award for the selected success indicator is greater than at least one award, if any, previously provided to the player for selecting a success indicator, and (e) repeat steps (b) to (d) until the determination is that the selected indicator is a failure indicator or the player selects all of the selectable indicators. Thus it is apparent that the more specific U.S. Patent No. 6,315,664 of claims 1-41 encompasses the application of claim 1-18. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent

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containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Am*  
APR

  
**XUAN M. THAI**  
**SUPERVISORY PATENT EXAMINER**

*TC3700*